

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte EDWARD GIORDANO, HOWARD A. MERCER and JOHN R. MILLER

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Appeal No. 96-3920  
Application 08/151,891<sup>1</sup>

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ON BRIEF

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Before COHEN, FRANKFORT and CRAWFORD, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 6, 8, and 10 through 13. These claims constitute all of the claims remaining in the application.

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<sup>1</sup>Application for patent filed November 15, 1993.

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Appellants' invention pertains to a marking pen, a method of unclogging a marking pen, and to a method of using a marking pen. An understanding of the invention can be derived from a reading of exemplary claims 1, 8 and 10, copies of which appear in the "APPENDIX" to the main brief (Paper No. 14).

As evidence of obviousness, the examiner has applied the documents listed below:

Gaines	1,271,457	Jul. 02, 1918
Bok	3,905,709	Sep. 16, 1975
Abe et al. (Abe)	4,568,214	Feb. 04, 1986
Dahm	1,811,081	Jun. 11,
1970		
(Germany) <sup>2</sup>		
Hong	2,194,138	Mar. 02,
1988		
(Great Britain)		

The following rejections are before us for review.

Claims 1 through 3, 5, 6, 8, and 10 through 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over the

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<sup>2</sup> Our understanding of this document is derived from a reading of a translation thereof prepared for the United States Patent and Trademark Office. A copy of the translation is appended to this opinion.

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German reference in view of Abe, the British document, and Gaines.

Claims 4 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over the German reference in view of Abe, the British document, and Gaines, as applied above, further in view of Bok.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 21), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 20 and 22).<sup>3</sup>

On page 3 of the main brief (Paper No. 20), appellants indicate that claims 1, 2, 3, 5, 6, and 12 stand or fall together, and that claims 4, 8, 10, 11, and 13 are separate and independently allowable claims. As to the first grouping of claims, we select claim 1 for review, with claims 2, 3, 5,

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<sup>3</sup> The noted answer and main and reply briefs supersede the earlier filed answer and main and reply briefs (Paper Nos. 14, 15, and 16)).

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6, and 12 standing or falling therewith; 37 CFR 1.192(c)(7).

#### OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims,<sup>4</sup> the applied teachings,<sup>5</sup> and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We reverse the examiner's respective rejections of appellants' claims.

The marking pen of independent claim 1 requires, inter alia, a flexible body defining a cavity containing ink, and a

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<sup>4</sup> We understand the recitation of "the pores" of said nib in claim 8, line 4, and claim 10, line 6 to denote that the earlier recited "writing nib", in each claim, clearly includes pores.

<sup>5</sup> In our evaluation of the applied teachings, we have considered all of the disclosure of each teaching for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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vent hole in the flexible walls of the body. The method of independent claim 8 requires, inter alia, a barrel having flexible sidewalls defining an ink reservoir, and a vent in a location in the sidewalls where the sidewalls can be flexibly displaced. The method of independent claim 10 requires, inter alia, a barrel

having flexible sidewalls while defining an ink reservoir, and a vent in the sidewalls in a location in the sidewalls where the sidewalls can be flexibly displaced.

We turn now to the evidence of obviousness.

The examiner relies upon the German document for its disclosure in an abstract appended to the face thereof. The pertinent language in the abstract being "Pressure is exerted on the outer housing to exude the colouring through the pen". The examiner apparently did not obtain a translation of this foreign language reference during the examination of this application. However, we note that a translation of the document was submitted by appellant as an attachment to Paper

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No. 4.

A reading of the translation of the German reference prepared for the PTO reveals that the disclosure text of the document itself fails to teach exertion of pressure on an outer housing to exude coloring through the pen. Accordingly, we conclude that one of ordinary skill in this art would not have comprehended from the specification of the German reference that

the walls of the shaft 7 were flexible or that the cosmetic pen was intended to operate other than by capillary flow to the fiber tip 1. As disclosed, the ventilation opening 12 in the wall of the shaft 7 simply connects the supply of coloring fluid with the atmosphere.

In light of the above we are in accord with the view of appellants that the referenced add-on abstract is simply not supported by the actual teaching of the German document.

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Thus, the abstract is clearly not an accurate abstract of the actual disclosure of the German document, and cannot be fairly relied upon. Moreover, a fair reading of the abstract reveals to us that it neither infers nor suggests a "flexible" housing.

For these reasons, we believe it quite appropriate to say that the German document does not disclose a (flexible) housing upon which (manual) pressure can be exerted by a user to exude coloring through the pen.

As to the other applied teachings, we find that they reveal relevant aspects of the claimed invention but collectively would not have overcome the deficiency of the German document or have been suggestive of appellants' invention. Of particular

significance is the Gaines patent. The patentee Gaines overcomes a problem comparable to the problem addressed by

appellants.<sup>6</sup> More specifically, Gaines overcomes the problem of clogged holes in a tip by using a finger to close off a small opening (air vent) 17 and exert pressure on a rubber bulb 15 to increase air pressure in the ink reservoir to force fluid through the openings in the tip for effectually cleaning the instrument. Of course, the structure of Gaines differs from the structure now claimed.

Since a *prima facie* case of obviousness has not been established, we need not address the argued secondary considerations (main brief, pages 10 through 12 and reply brief, pages 3 through 5).

In summary, this panel of the board has:

reversed the rejection of claims 1 through 3, 5, 6, 8, and 10 through 12 under 35 U.S.C. § 103 as being unpatentable over the German reference in view of Abe, the British document, and Gaines; and

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<sup>6</sup> Appellants overcome the problem of clogging of marker tips or nibs by applying pressure to a reservoir to force clogging material from the pores of the nib and effectively unclog the nib (specification, pages 1 and 2).



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reversed the rejection of claims 4 and 13 under 35 U.S.C.  
§ 103 as being unpatentable over the German reference in view  
of Abe, the British document, Gaines, and Bok.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

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